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10/821,701	04/09/2004	John Melideo	J008-P07651US	1530
33356 7590 06/26/2008 SoCAL IP LAW GROUP LLP 310 N. WESTLAKE BLVD. STE 120 WESTLAKE VILLAGE, CA 91362			EXAMINER PHAN, JOSEPH T	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/821,701	Applicant(s) MELIDEO, JOHN	
	Examiner Joseph T. Phan	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/18/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 41-60 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 41-60 recites "A machine readable medium comprising computer software..." however applicant's disclosure does not mention a "machine readable medium" and therefore causes indefiniteness and further causes 'non-statutory subject-matter' issues as the medium is not defined. Appropriate clarification and/or correction is required.

3. Claims 1-60 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Independent claims 1, 21, 33, 37, 38, 41, 49, and 57 recites the limitation "initiating a telephone call between a predefined telephone number and the activated telephone number in response to the recognizing/activation." However, it is noted the "predefined telephone number" is taught as the "call back number" in the specification (page 31 paragraph 0088) and therefore it

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is not known how a telephone call is initiated between the 'call back number' and the activated telephone number(called party) in response to recognizing/activation of the activated telephone number without first reciting initial steps of an originating telephone call to the activated telephone number.

Furthermore, if it is shown that the 'predefined telephone number' is the originating telephone number of the originating call' then claims 3-5 would not be enabled as it would not be known how the 'initiating telephone call' would be initiated from a cellular phone near the user.

Appropriate clarification and/or correction is required.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 21, 33, 37, 38, 41, 49, and 57 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 21, 33, 37, 38, 41, 49, and 57 does not recite any symbols to separate each recited limitation which causes confusion as it is not clear where each limitation step ends.

For example, claim 37 lines 6-7 recites "...via the toolbar either..., or" and line 13 recites "initiating a telephone call" and therefore it is unclear if the 'either' refers to the 'initiating' also. It is also noted that none of these claims recite the term 'and' to separate the last limitation if there are several limitations. If there are no separation symbols because there is only one recited limitation, then there would be indefinite issues. Appropriate clarification and/or correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-60 rejected under 35 U.S.C. 102(e) as being anticipated by Cho et al., Patent #6,834,048.

Regarding claims 1 and 41, Cho teaches a method and machine-readable medium of telephone call initiation via a toolbar included in an Internet web browser: identifying telephone numbers included in a web page requested by a user of the Internet web browser(Cho Fig.2, col.4 lines 35-45) conspicuously displaying the identified telephone numbers when the web page is displayed recognizing activation by the user of one of the conspicuously displayed identified telephone numbers included in the web page as an activated telephone number(Cho col.4 lines 45-49 and col.5 lines 48-60) initiating a telephone call between a predefined telephone number and the activated telephone number in response to the recognizing(col.3 lines 11-15, col.6 lines 44-65, col.7 lines 22-42; user app. has a predefined telephone number for two-way connection).

Regarding claims 2 and 42, Cho teaches a method and machine-readable medium of claims 1 and 41 wherein the predefined telephone number is a web browser user telephone number(col.3 lines 11-15 and col.4 lines 50-67).

Regarding claims 3 and 43, Cho teaches a method and machine-readable medium of claims 2 and 42 wherein the web browser user telephone number is for an adjacent telephone near to where the user is accessing the web browser(col.3 lines 11-15, col.6 lines 44-65, col.7 lines 22-42).

Regarding claims 4 and 44, Cho teaches a method and machine-readable medium of claims 3 and 43 wherein the adjacent telephone is a cellular telephone(col.3 lines 11-21 col.6 lines 44-65, col.7 lines 22-42).

Regarding claims 5 and 45, Cho teaches a method and machine-readable medium of claims 3 and 43 wherein the adjacent telephone is physically connected to a public switched telephone network(col.3 lines 11-21, col.6 lines 44-65, col.7 lines 22-42).

Regarding claims 6 and 46, Cho teaches a method and machine-readable medium of claims 1 and 41 wherein the predefined telephone number is requested during user registration of the toolbar(col.3 lines 11-21, col.6 lines 44-65, col.7 lines 22-42).

Regarding claims 7 and 47, Cho teaches a method and machine-readable medium of claims 1 and 41 wherein the predefined telephone number is requested when a user logs in to the toolbar(col.3 lines 11-21, col.6 lines 44-65, col.7 lines 22-42).

Regarding claims 8 and 48 Cho teaches a method and machine-readable medium of claims 1 and 41 wherein the initiating comprises requesting a callback telephone number from the user and assigning the callback number as the predefined telephone number(col.3 lines 11-21, col.6 lines 44-65, col.7 lines 22-42).

9.

Regarding claims 9 and 49 Cho teaches a method and machine-readable medium of

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claims 1 and 41 further comprising:

receiving call status information providing the call status information to the user(col.9 lines 28-37).

Regarding claims 10 and 50, Cho teaches a method and machine-readable medium of claims 9 and 49 wherein the providing comprises: displaying the call status information(col.9 lines 28-37).

Regarding claims 11 and 51, Cho teaches a method and machine-readable medium of claims 1 and 41 wherein the toolbar includes a button to allow a user to turn the conspicuously displaying on and off(Fig.5A; the 'file' button can turn the display on and off).

Regarding claims 12 and 52, Cho teaches a method and machine-readable medium of claims 1 and 41 wherein the toolbar includes a user interface item to allow a user to provide the predefined telephone number(col.3 lines 11-21).

Regarding claims 13 and 53, Cho teaches a method and machine-readable medium of claims 1 and 41 wherein the toolbar includes a user interface item to list the identified telephone numbers(Fig.5A)

Regarding claims 14 and 54, Cho teaches a method and machine-readable medium of claims 1 and 41 wherein the initiating comprises:
causing a signal to be sent to a switch instructing the switch to initiate the telephone call(col.2 lines 1-10).

Regarding claims 15 and 55, Cho teaches a method and machine-readable medium of claims 1 and 41 wherein the causing includes:
transmitting the predefined telephone number and the displayed telephone number to the switch

(Fig.4 and col.2 lines 1-10).

Regarding claims 16 and 56, Cho teaches a method and machine-readable medium of claims 14 and 54 wherein the causing includes:

sending a call initiation message for causing the signal to be sent to the switch(Fig.4 and col.2 lines 1-10).

Regarding claims 17 and 57, Cho teaches a method and machine-readable medium of claims 15 and 55 wherein the call initiation message is sent directly to the switch(Fig.4 and col.2 lines 1-10).

Regarding claims 18 and 58, Cho teaches a method and machine-readable medium of claims 16 and 56 wherein the call initiation message is sent to a server, the sending comprising; opening a TCP connection to authenticate the user and start a call session with the server(Fig.4 and col.2 lines 1-10).

Regarding claims 19 and 59 Cho teaches a method and machine-readable medium of claims 16 and 56 wherein the call initiation message wherein the call initiation message comprises one or more HTTP requests(Fig.4 and col.2 lines 1-10).

Regarding claims 20 and 60 Cho teaches a method and machine-readable medium of claims 16 and 56 wherein the call initiation message comprises one or more SIP messages(Fig.4 and col.2 lines 1-10).

Regarding claims 21 and 49, Cho teaches a method and machine-readable medium of telephone call initiation via a toolbar included in an Interact web browser, the method comprising
intercepting web page data directed to the web browser(col.4 lines 25-49)

scanning the web page data for associated data items included in an address book included with or accessible to the toolbar (Fig.5a, col.4 lines 25-49, and col.6 lines 25-43; address book is accessible to the toolbar browser)

identifying the associated data items found in the web page data as found data items(col.4 lines 25-67)

pairing a telephone number from the address book with each of the found data items(Fig.4-5A, and col.6 lines 16-47)

preparing a list of found data items and corresponding telephone numbers for the web page(Fig.4-5A, and col.6 lines 16-47)

altering the normal display of the found data items to make the found data items(Fig.4-5A, and col.6 lines 16-47)

conspicuous on a web page in which the data is included recognizing the activation of one of the found data items(Fig.4-5A, and col.6 lines 16-47)

initiating a telephone call between a predefined telephone number and the telephone number corresponding to an activated found data item(Fig.4 and col.6 lines 44-65).

Regarding claim 22, Cho teaches a method of claim 21 wherein the predefined telephone number is a web browser user telephone number(col.3 lines 11-21 and col.6 lines 55-65).

Regarding claims 23 and 50, Cho teaches a method and machine-readable medium of claims 22 and 49 wherein the web browser user telephone number is for an adjacent telephone near to where the user is accessing the web browser(col.3 lines 11-21).

Regarding claims 24 and 51, Cho teaches a method and machine-readable medium of claims 23 and 50 wherein the adjacent telephone is a cellular telephone(col.3 lines 11-21).

Regarding claims 25 and 52, Cho teaches a method and machine-readable medium of claims 23 and 50 wherein the adjacent telephone is physically connected to a public switched telephone network(col.3 lines 11-21).

Regarding claims 26 and 53, Cho teaches a method and machine-readable medium of claims 21 and 49 wherein the predefined telephone number is requested during user registration of the toolbar(col.3 lines 11-21).

Regarding claims 27 and 54, Cho teaches a method and machine-readable medium of claims 21 and 49 wherein the predefined telephone number is requested when a user logs in to the toolbar(col.3 lines 11-21 and col.6 lines 55-65).

Regarding claims 28 and 55, Cho teaches a method and machine-readable medium of claims 21 and 49 wherein the initiating comprises requesting a callback telephone number from the user and assigning the callback number as the predefined telephone number(col.3 lines 11-21 and col.6 lines 55-65).

Regarding claims 29 and 56, Cho teaches a method and machine-readable medium of claims 21 and 49 further comprising: receiving call status information displaying the call status information(col.9 lines 28-37).

Regarding claims 30 and 57, Cho teaches a method and machine-readable medium of claims 21 and 49 wherein the toolbar includes a user interface item to allow a user to set the altering of the found data items in the web page to be on and off(Fig.5a and col.6 lines 18-47).

Regarding claims 31 and 58, Cho teaches a method and machine-readable medium of claims 21 and 49 wherein the toolbar includes a user interface item to allow a user to provide the predefined telephone number(col.3 lines 11-21 and col.6 lines 55-65).

Regarding claims 32 and 59, Cho teaches a method and machine-readable medium of claims 21 and 49 wherein the toolbar includes a user interface item to list the found data items(col.3 lines 11-21 and col.6 lines 55-65).

Regarding claims 33 and 57, Cho teaches a method and machine-readable medium of telephone call initiation via a toolbar included in an Internet web browser(Fig.4), comprising intercepting web page data for a web page directed to the Internet web browser scanning the web page data for telephone numbers and associated data identifying telephone numbers in the web page data as identified telephone numbers identifying associated data in the web page data as identified associated data(col.4 24-55)
altering the normal display of the identified telephone numbers and the identified associated data included in the found items list to make the identified telephone numbers and the identified associated data conspicuous on the web page(col.6 lines 18-57)
recognizing the activation of one of the identified telephone numbers or one of the identified associated data as an activated item(col.6 lines 18-57)
initiating a telephone call between a predefined telephone number and a telephone number corresponding to an activated item(col.6 lines 44-65).

Regarding claims 34 and 58, Cho teaches claims 33 and 57 wherein the toolbar includes a user interface item to allow a user to set the altering of the identified telephone numbers and the identified associated data in the web page to be on and off.

Regarding claims 35 and 59, Cho teaches claims 33 and 57 wherein the toolbar includes a user interface item to allow a user to provide the predefined telephone number.

Regarding claims 36 and 60, Cho teaches claims 33 and 57 wherein the toolbar includes a

user interface item to list the identified telephone numbers and the identified associated data.

Regarding claim 37, Cho teaches a method of telephone call initiation via a toolbar included in an Internet web browser(Fig.4):
identifying telephone numbers included in a web page requested by a user of a web browser
conspicuously displaying the identified telephone numbers when displaying the web page
providing a list of all identified telephone numbers via the toolbar either (col.6 lines 17-47)
receiving a user selection of one of the identified telephone numbers from the list as an activated telephone number, or recognizing activation by the user of one of the conspicuously displayed identified telephone numbers included in the web page as the activated telephone number
initiating a telephone call between a predefined telephone number and the activated telephone number in response to the recognizing or the receiving(col.6 lines 17-65).

Regarding claim 38, Cho teaches a method of telephone call initiation via a toolbar included in an Internet web browser(Fig.4), the method comprising
intercepting web page data for a web page directed to the web browser scanning the web page data for telephone numbers identifying telephone numbers in the web page data as identified telephone numbers (col.6 lines 16-47)
looking up the identified telephone numbers in an address book to create a found telephone numbers list (Fig.5a and col.6 lines 36-43)
altering the normal display of at least one of the found telephone numbers to make the found telephone number conspicuous on the web page in which the found telephone number is included
recognizing activation of one of the found telephone numbers(col.6 lines 16-47)
initiating a telephone call between a predefined telephone number and an activated found

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telephone number(col.6 lines 44-64).

Regarding claim 39, Cho teaches the method of claim 38 wherein the address book is prepared by a personal information manager included in the toolbar(Fig.5 and col.6 lines 36-43).

Regarding claim 40, Cho teaches the method of claim 38 wherein the address book is prepared by an application program external to the toolbar and the web browser.(Fig.5a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T. Phan whose telephone number is (571) 272-7544. The examiner can normally be reached on Mon-Fri 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joseph T Phan/

Examiner, Art Unit 2614

/Curtis Kuntz/

Supervisory Patent Examiner, Art Unit 2614